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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/553,683 04/21/00 WEBB, M.D.

L F. 003

QM22/0705
HOPGOOD CALIMAFDE KALIL & JUDLOWE LLP
60 EAST 42ND STREET
NEW YORK NY 10165

EXAMINER

MANTIS MERCADER, E

ART UNIT

PAPER NUMBER

3737

DATE MAILED:

07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/553,683

Applicant(s)

WEBB, M.D., LAWRENCE
XAVIER

Examiner

Eleni Mantis Mercader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

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DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it exceeds the range of 50-250 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Orrison'233.

Orrison'233 teaches a surgical targeting system for adding an indicia image to a radiographic image of a body resulting from passage of image radiation through the body, said targeting system comprising:

an antimicrobial drape having an inner surface of sufficient flexibility to conform to at least a portion of an outer surface of the body, said drape being puncturable to provide access to

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the outer surface of the body, said drape being transparent to the imaging radiation (col. 5, lines 1-41);

an indicia affixed to a portion of said drape, said indicia being opaque to the imaging radiation resulting in the indicia image corresponding to said indicia (col. 15, lines 6-38); and

a means for fixing said indicia relative to the outer surface of the body such that said indicia provides a reference on the body for correlating portions of the body for correlating portions of the body to radiographic body image (col. 15, lines 6-19).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orrison'233 in view of Shih et al.'985.

Regarding claims 2 and 5-6, Orrison'233 teaches the use of a sterile drape (col. 5, lines 30-41). Orrison'233 does not teach the use of adhesive plastic intergraded with iodophor. In the same field of endeavor, Shih et al.'985 teaches the use of adhesive plastic integrated with iodophor (col. 3, lines 12-27). It would have been obvious to one skilled in the art at the time that the invention was made to have used the adhesive plastic integrated with iodophor as a sterile drape in the invention of Orrison'233 in order to avoid sterilization procedures such as gas sterilization or irradiation sterilization.

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7. Claims 4 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orrison'233 in view of Mosby'985.

Orrison'233 teaches all the features of the instant invention except for the polar coordinates, having a cylindrical and a hemispherical portion. In the same field of endeavor, Mosby'985 teaches the use of polar coordinates having radiopaque markings and having a cylindrical and a hemispherical portion (col. 6, lines 23-61; also see Figures 1-3). It would have been obvious to one skilled in the art at the time that the invention was made to have modified the sterile drape Orrison'233 to the plastic having polar coordinates and having a cylindrical and a hemispherical portion with radiopaque markings as taught by Mosby'985 in order to be able to accurately biopsy human breast.

8. Claims 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orrison'233 in view of Mosby'985 and further in view of Shih et al.'985.

Regarding claims 12-27, Orrison'233 in view of Mosby'985 teach all the features of the instant invention except for the use of plastic intergraded with iodophor. In the same field of endeavor, Shih et al.'985 teaches the use of adhesive plastic integrated with iodophor (col. 3, lines 12-27). It would have been obvious to one skilled in the art at the time that the invention was made to have used the adhesive plastic integrated with iodophor as a sterile drape in the invention of Orrison'233 in view of Mosby'985, in order to avoid sterilization procedures such as gas sterilization or irradiation sterilization.

9. Claims 3 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orrison'233 in view of Cosman et al.'265.

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Regarding claim 3, Orrison'233 teaches all the features of the instant invention except for the indicia having coordinates, which are rectilinear or orthogonal. In the same field of endeavor, Cosman et al.'265 teach the use of indicia having coordinates, which are rectilinear or orthogonal in order to accurately localize targets inside the body (col. 3, lines 11-64). It would have been obvious to one skilled in the art at the time that the invention was made to have used the indicia having coordinates, which are rectilinear or orthogonal as taught by Cosman et al.'265 in the invention of Orrison'233 in order to accurately localize targets inside the body.

Regarding claims 28-29, it would have been obvious to one skilled in the art at the time that the invention was made to have used the targeting system as taught by Orrison'233 in view of Cosman et al.'265 at any of area of interest such as the femur of the body.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cherry et al.'121 teach an abdominal grid for intrauterine fetal transfusion.

Jinkins'136 teach a computerized tomography radiograph data transfer cap.

Front'201 teaches a stereotactic diagnosis and treatment with reference to a combined image.

Saleh'103 teaches improvements in the radiographic analysis of bones.

Zinreich et al.'030 teaches non-invasive multi-modality radiographic surface markers.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Wed. - Wed., 7:00 a.m.-5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703 308-7635. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-0758 for regular communications and 703 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.


Marvin M. Lateef
Supervisory Patent Examiner
Group 3700



EMM
July 1, 2001